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EXAMINER

HAAS, WENDY C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/755,607 | Applicant(s) JAMIESON, ANDREW W. | |
| | Examiner Wendy C Haas | Art Unit 1661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Prosecution Application

The request filed on January 12, 2004 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 10/073,447 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Plant Breeder's Right Application Number 97-999, published April 30, 1997 (more than one year prior to the priority date of the instant application) in view of applicant's admission of July 8, 2003 (of record in Application Serial Number 10/073,447) that "Evangeline" was first commercialized in Canada in 1999." The Examiner refers applicant to In re Elsner, 381 F.3d 1125, 72 U.S.P.Q. 1038 (Fed. Cir. 2004), which holds that a published application, combined with foreign public possession of a claimed plant may constitute an anticipatory reference under 35 U.S.C. § 102(b).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Plant Breeder's Right Grant Number 0617, published August 10, 1999 (more than one year prior to the priority date of the instant application) in view of in view of applicant's admission of July 8, 2003 (of record in Application Serial Number 10/073,447) that "Evangeline" was first commercialized in Canada in 1999." The Examiner refers applicant to In re Elsner, 381 F.3d 1125, 72 U.S.P.Q. 1038 (Fed. Cir. 2004), which holds that a published application, combined

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with foreign public possession of a claimed plant may constitute an anticipatory reference under 35 U.S.C. § 102(b).

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

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The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Applicant must insert the Botanical Designation and Variety Denomination of the claimed plant in a separate section at the beginning of the specification, preceding the Background of the Invention, in order to comply with 37 CFR 1.163(c)(4). Correction is needed.
- B. Page 1, line 4, applicant should enclose the breeder's designation 'K93-1' in single quotation marks, as this is the convention in the art.
- C. Applicant is requested to disclose whether the comparison cultivars 'K88-4', 'NYUS119' and 'Veestar' have been patented in the United States, are currently the subjects of any pending U.S. plant patent applications, or are unpatented. If patented, --(United States Plant Patent Number)-- should be inserted after the appropriate cultivar name. If the subject of a pending application, such should be referred to by serial number (United States Plant Patent Application Serial Number). If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name, or such could simply be acknowledged in applicant's next response. The Examiner conducted a search of the named varieties; they appear to be unpatented. However, this search is not exhaustive, as the newest applications may not be found during the search.
- D. Page 1, line 10, applicant should specify that the claimed variety originated as a single plant.

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E. Pages 1 and 2, applicant should change each instance of the word “FIG.” to read: --Fig.--.

As the drawing sheets of record are not so labeled, it is inappropriate to refer to the drawing as FIG. in the specification. The specification and drawings must correspond to each other in this regard.

F. Page 2, applicant should change the parenthetical expression “(patent pending)” following ‘Sable’ to read (United States Plant Patent Application Serial Number 09/935,478, now abandoned; United States Plant Patent Application Publication US 2003/0046739 P1; United States Plant Patent Application Serial Number 10/747,871; United States Plant Patent Application Publication US 2004/0205869 P1) --.

G. Page 2, applicant recites : “the new variety is botanically identified as *Fragaria ananassa*”; the correct botanical designation is – *Fragaria x ananassa* --. Correction is needed.

H. Page 4, line 19, applicant refers to the “seeds” of the claimed plant, but appears to be describing the achenes of same. Clarification is needed.

I. Page 5, TABLE 2, applicant sets forth the “Flower truss length”, but fails to provide units for the measurement given. Correction is needed.

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J. Page 5, TABLE 2, applicant sets forth “5.4” and “6.9” flowers per truss. Applicant should amend this recitation by providing an accurate number or by identifying the number given as an average, as appropriate.

K. Page 5, TABLE 2, applicant sets forth the “Seed position”, but appears to be describing the achene position. Clarification is needed.

L. Page 5, TABLE 2, applicant sets forth the “Fruit firmness (N)” and the “Skin toughness (g)”, but fails to specify what “(N)” and “(g)” indicate as units. Clarification is needed.

M. The following claim is suggested: -- A new and distinct variety of strawberry plant, as herein described and illustrated.--.

The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Conclusion

No claim is allowed.

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Comments

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

KENT BELL
PRIMARY EXAMINER

Kent L. Bell

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ATTACHMENT
REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicants and/or the assignee(s) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when the claimed plant variety, '**Evangeline**', was publicly available prior to the filing date of the instant application. In applicant's Response Under 37 CFR 1.105 (dated July 8, 2003 and of record in Application Serial No. 10/073,447) applicant states "the claimed variety was first publicly available in Canada after May 3, 1999." This response does not identify exactly when the claimed plant was publicly available.

In response to this requirement please respond to the following interrogatories and/or provide the following documents:

(1) For each instance of public availability or sale of the claimed plant anywhere in the world occurring prior to February 11, 2001, please provide the date the plant was sold or made available, the location where the plant was sold or made available, the name person or entity who sold or transferred possession of the plant, the name of the person or entity who purchased or received possession of the plant as well as any written proof of the sale or transfer, including facsimiles, archived internet records and/or e-mail communications.

(2) Applicant may limit the response to five (5) instances of sale or transfer of the claimed plant occurring prior to February 11, 2001, if necessary.

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The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicants' first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicants are reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicants do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.